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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,858	11/01/2000	Brian Kevin Daly	2000-0063	3715

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KLARQUIST SPARKMAN, LLP  
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PORTLAND, OR 97204

EXAMINER

GARY, ERIKA A

ART UNIT	PAPER NUMBER
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2681

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DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/703,858

Applicant(s)

DALY, BRIAN KEVIN

Examiner

Erika A. Gary

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-15 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, and 10-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Chatterjee et al., US Patent Number 6,282,421 (hereinafter Chatterjee).

Regarding claim 1, Chatterjee discloses a method of activating a mobile station for communicating with a telecommunications network, comprising the steps of: (a) in a first registration, providing the mobile station with a permanent mobile station ID [fig. 5]; (b) in a second registration, receiving the permanent mobile station ID from the mobile station [fig. 6]; and (c) communicating programming data to the mobile station [figs. 5, 6].

Regarding claim 2, Chatterjee discloses the first registration comprises the steps of receiving a temporary activation mobile station ID from a mobile station; verifying the temporary activation mobile station ID; and communicating a permanent mobile station ID to the mobile station [fig. 5; col. 9: line 59 – col. 10: line 28].

Regarding claim 3, Chatterjee discloses the second registration comprises the steps of: receiving the permanent mobile station ID from the mobile station; verifying the permanent mobile station ID; and communicating programming data to the mobile station [fig. 6; col. 10: lines 29-51].

Regarding claim 4, Chatterjee discloses a method of activating a mobile station for communicating with a telecommunications network, comprising the steps of: of receiving a temporary activation mobile station ID from a mobile station; verifying the temporary activation mobile station ID; communicating a permanent mobile station ID to the mobile station [fig. 5; col. 9: line 59 – col. 10: line 28]; receiving the permanent mobile station ID from the mobile station; verifying the permanent mobile station ID; and communicating programming data to the mobile station [fig. 6; col. 10: lines 29-51].

Regarding claim 5, Chatterjee suggests receiving the temporary activation mobile station ID (it is inherent in the art to also send the ESN) of the mobile station at a mobile switching center, and sending a registration notification to an over-the-air activation function; and sending a registration notification containing the permanent mobile station ID from the over-the-air activation function to the mobile switching center [fig. 5; col. 9: line 59 – col. 10: line 28].

Regarding claim 6, Chatterjee suggests receiving the permanent mobile station ID (it is inherent in the art to also send the ESN) from the mobile station at the mobile switching center; and the mobile switching center sending a registration notification to a home location register assigned to the permanent mobile station ID [fig. 6; col. 10: lines 29-51].

Regarding claim 10, Chatterjee discloses a method of activating a mobile station in a wireless network, comprising: transmitting a permanent mobile station ID from the wireless network to the mobile station; transmitting the permanent mobile station ID from the mobile station to the network; and communicating programming data to the mobile station in response to the transmission of the permanent mobile station ID by the mobile station [figs. 5, 6].

Regarding claim 11, Chatterjee discloses storing subscription information for a subscriber in a customer database; and assigning the permanent mobile station ID to the subscriber associated with the subscription information [col. 2: lines 23-31].

Regarding claim 12, Chatterjee discloses the permanent mobile station ID is a permanent MIN [col. 10: lines 35-37].

Regarding claim 13, it is inherent for a permanent mobile station ID to be a permanent IMSI based on the type of wireless network.

Regarding claim 14, Chatterjee discloses the programming data communicated to the mobile station includes at least one number assignment module (NAM) parameter [col. 7: lines 33-35].

Regarding claim 15, it is inherent to store the at least one NAM parameter in the mobile station.

### ***Response to Arguments***

3. Applicant's arguments filed March 22, 2004 with respect to claims 1-6 and 10-15 have been fully considered but they are not persuasive. Applicant argues that

Chatterjee does not teach the first and second registrations. However, the Examiner respectfully disagrees. Chatterjee discloses a first registration wherein a temporary activation mobile station ID is received (the dummy MIN). Once this ID is verified, the mobile station receives a permanent ID. Chatterjee further teaches a second registration (i.e. activation in a new area) wherein the permanent mobile station ID is received. Subsequent to this, the mobile station receives programming data. Hence, the claim limitations are read in the reference.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., using a first and second registration process to initially activate a new mobile station) are not recited in the rejected claim(s). For example, claim 1 broadly states "a method of activating a mobile station comprising...". However, the "activation" of the mobile station is not tied into the rest of the claim language. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments, see pages 9, 10, filed March 22, 2004, with respect to claims 7-9 have been fully considered and are persuasive. The rejection of claims 7-9 has been withdrawn.

***Allowable Subject Matter***

4. Claims 8-9 are allowed.

5. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 703-308-0123. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, supervisor Nay Maung can be reached on 703-308-7745. The fax phone numbers for the organization

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where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750 or to the 2600 Customer Service Office at 703-306-0377.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9306 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, VA., Sixth Floor (Receptionist).

Erika Gary  
Primary Examiner

EAG  
May 25, 2004

  
ERIKA GARY  
PATENT EXAMINER